

Application No.: 09/220,910
Amendment dated: December 7, 2006
Office Action dated July 7, 2006

REMARKS/ARGUMENTS

Claims 1-41 were previously cancelled. Claims 42-77 are pending. Claims 42, 56, 61, 65, 68 and 69 are rejected under 35 U.S.C §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 68 is rejected under 35 U.S.C §112, first paragraph, as failing to comply with the enablement requirement. Claim 56 is rejected under 35 U.S.C §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 42-70 are rejected on the ground of nonstatutory double patenting over claims 1-16 of U.S. Patent No. 6,452,610 B1 ('610) since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent. Claims 42-68 are rejected under 35 U.S.C. §102(e) as being anticipated by Rosenberg et al., U.S. Patent No. 5,956,484. Claims 69-77 are rejected under 35 U.S.C. §103(a) as being unpatentable over Rosenberg et al., in view of Knowlton et al., U.S. Patent No. 5,973,692.

REJECTIONS UNDER 35 U.S.C. §112, first paragraph

With regard to the §112, first paragraph rejections, claim 68 stands rejected under 35 U.S.C. §112, first paragraph, as based on a disclosure which is not enabling. The Office Action stated that "unspecified address" is not disclosed in the specification. While the term "unspecified address" may not literally appear in the specification, one skilled in the art would recognize and know how to practice the claimed invention upon reading, for example, paragraph [0038] which states:

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[0038] Any of the previous embodiments may be implemented to solve this CC list problem using approaches similar to those discussed above with respect to attaching secondary document 50. One modification may be to change the indicators which are sought to be detected in primary document 50. Instead of words such as "attached," or phrases such as "I have attached," the indicators may include words or phrases indicating that a person/entity should be on the CC list, such as the term "CC" or phrase "I have CC'd." Another modification may be that mail directories and mailing lists will be searched for the appropriate e-mail address instead of searching for files once an indicator has been detected. A further modifications may be that, instead of or in addition to attaching secondary document 60, an e-mail address will be added to the list of secondary recipients.

One skilled in the art at the time the invention was made would have recognized that one example of an unspecified address may be an e-mail address of a person/entity that should be on the CC list, but was not originally.

Therefore, Applicants submit that the claims in their present form overcome all 35 U.S.C. §112, first paragraph issues and are allowable in their present form.

REJECTIONS UNDER 35 U.S.C. §112, second paragraph

Claims 42, 56, 61, 65, 68 and 69 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention (*i.e., un-selected indicator*).

Claim 56 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention – "a third storage device to store an indicator". The Office

Action states:

It was unclear that the storage device is a hard disk or the other computer (*i.e.*: a router, gateway with routing table, Network translation table). An

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indicator could be IP address, URL, hyperlink and any device connected to [sic] Internet has its own address or indicator. It was obvious that any computer connected to [sic] network has one address, indicator. Examiner can not determine what applicant [sic] intention.

The specification in paragraphs [0019] and [0020] indicate that a storage device, particularly the third storage device, may store a plurality of indicators. However, whether or not the storage device is a hard disk or another computer is not indefinite because as indicated in paragraph [0019] "all of the information stored on first, second and third storage devices 20, 30, 40 may also be stored on a single storage device." Thus, the storage may be on a single hard disk or distributed over several other computers. Moreover, being able to store an IP address of another device for purposes of communication, does not preclude storing the plurality of indicators. Example indicators are described in paragraph [0020]. One skilled in the art at the time the invention was made would have been able to view the limitation in light of the specification in order to determine what Applicant regards as his invention.

Therefore, Applicants submit that the claims in their present form overcome all 35 U.S.C. §112, second paragraph issues and are allowable in their present form.

DOUBLE PATENTING

Claims 42-70 are rejected on the ground of nonstatutory double patenting over claims 1-16 of U.S. Patent No. 6,452,610. A terminal disclaimer has been concurrently filed herewith to overcome this rejection.

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REJECTIONS UNDER 35 U.S.C. § 102(e)

Claims 42-68 were rejected under 35 U.S.C. § 102(e) as being anticipated by Rosenberg et al (U.S. Patent No. 5,956,484).

Applicants respectfully submit the cited reference does not teach or suggest “[a] method comprising: processing said primary document to locate an un-selected indicator; identifying a secondary document associated with said located un-selected indicator; and *attaching said secondary document to said primary document to encapsulate said secondary document within said primary document*” (e.g., as described in claim 42).

The Office Action states that Rosenberg discloses “attaching said secondary document to said primary document to encapsulate said secondary document within [sic] primary document.” Office Action dated 7/7/2006, page 5, lines 22-23. The Office Action cited to Rosenberg, col 12 lines 40-52, which states:

In FIG. 8, the “Parse And Interpret HTML Component” or simply “Process HTML Component” step 160 of FIG. 7a is illustrated in greater detail. In FIG. 8, process 160 begins at 206 and, in a step 208, it is determined whether there is an embedded “tag” for a force object, e.g. a tag having an .IFF reference. An example of the embedded tag is shown at the EMBED command 170 of FIG. 7b. If there is such a tag, step 210 uses the plug-in software of the present invention to interpret the .IFF file, and the process is completed at 212. Otherwise, another type of HTML command has been encountered, and the standard web browser parser and interpreter processes this HTML component in a step 214, after which the process is completed at 212.

However, the “embedded tag” discussed in Rosenberg is not “attaching said secondary document to said primary document to encapsulate said secondary document within said primary document.” First, an .IFF file is not encapsulated within the primary document, rather it is called and executed by the web browser. See Rosenberg, column 12, lines 1-3.

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Second, the EMBED command does not encapsulate *documents* because, as stated in Rosenberg, the EMBED command “essentially embeds function calls which are handled by the web browser.” See column 11, line 67 to column 12, line 1. Thus, neither the embed command nor the reference to the .IFF file disclose or teach “attaching said secondary *document* to said primary document to encapsulate said secondary document within said primary document.”

Under 35 U.S.C. §102, anticipation requires that each and every element of the claimed invention be disclosed in the prior art. *Akzo N.V. v. U.S. International Trade Commission*, 1 U.S.P.Q. 2d 1241, 1245 (Fed. Cir. 1986). As shown above, they do not. As such, Applicants submit independent claim 42 is allowable.

Independent claims 56, 61 and 68 contain similar allowable limitations, and therefore are allowable as well. Dependent claims 43-55, 57-60 and 62-67 are allowable for depending on an allowable base claim.

REJECTIONS UNDER 35 U.S.C. §103

Claims 69-77 stand rejected under 35 U.S.C. §103 as being obvious over U.S. Patent No. 5,956,484 to Rosenberg in view of U.S. Patent No. 5,973,692 to Knowlton. Applicant traverses the rejection and respectfully submits that claims 69-77 are not obvious in light of the proposed combination of references.

Applicants respectfully submit the cited references do not teach, suggest or describe “[a] method comprising: processing said primary document to locate an un-selected indicator; identifying a secondary document associated with said

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located un-selected indicator; and *automatically encapsulating said secondary document within said primary document upon identifying said secondary document*" (e.g., as described in claim 69).

Neither Rosenberg nor Knowlton teach or suggest the recited feature of Applicant's claim 69. The Office Action admits that Rosenberg does not explicitly detail "automatically encapsulating said secondary document within said primary document upon identifying said secondary document." Office Action, page 13, lines 8-10. The Office Action states that Knowlton apparatus discloses a system for the capture and indexing of graphical representation of files information sources using Visual Links Automatic capture engine. However, the system in Knowlton does not encapsulate a secondary document within a primary document, rather the "Visual Links Automatic Capture Engine . . . serves as a visual representation to the user of the associated document or file." Knowlton, column 10, lines 51-54.

To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As shown above, the prior art does not teach or suggest all claim

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limitations. Accordingly, the current rejection of claim 69 is lacking, and the rejection should be withdrawn.

Moreover, Applicant also respectfully submits that the rejection is improper because the Office Action has not provided a proper motivation to combine the cited references. To reject, the Office Action must cite a suggestion in the prior art to combine the references that is "clear and particular". *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). The requirement is for "actual evidence" of the proposed motivation to combine. *Teleflex, Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1334, 63 USPQ2d 1374 (Fed. Cir. 2002). The proffered reasoning given for the proposed combination in the present Office Action is that it would be obvious one of ordinary skill in the art to combine Rosenberg and Knowlton to "provide a visual link without increasing the size of the file." The recited reason of providing only a link does not recite the limitation of encapsulating the secondary document within the primary document. No support is provided from any of the cited references that would tend to show that an ordinary artisan would have been led by the cited references to make the particular modification proposed in the Office Action. Applicant traverses the proposed combination; Applicant respectfully submits that this alleged motivation to combine is merely picking and choosing features from the cited references, using Applicant's claimed invention as a menu or map. This type of improper hindsight reconstruction, which is not even reciting the specific limitations of claim 69, is an improper hindsight reconstruction. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 69 for at least this additional reason.

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Claims 70-77 depend from claim 69, and therefore should be allowable for at least the same reasons as those given above for claim 69.

For at least the above reasons, Applicants respectfully submit that the present case is in condition for allowance and respectfully requests that the Examiner issue a notice of allowance.

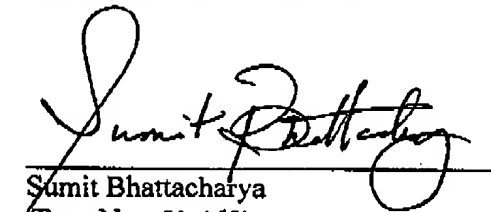
The Office is hereby authorized to charge any fees determined to be necessary under 37 C.F.R. §1.16 or §1.17 or credit any overpayment to Kenyon & Kenyon LLP
Deposit Account No. 11-0600.

The Examiner is invited to contact the undersigned at (408) 975-7500 to discuss any matter concerning this application.

Respectfully submitted,

KENYON & KENYON LLP

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